

Remarks

Reconsideration of this Application is respectfully requested.

Based on the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

The rejections of independent claims 1 and 19 are respectfully traversed.

Applicant first notes that the rationale the Examiner is using to reject the claims has changed since the last Office Action. In the February 12, 2008 Office Action, the Examiner cited *In re Stevens*, 212 F.2d 197, 101 USPQ 284 (CCPA 1954) to allege that T-shaped or V-shaped configurations for weld seams are merely matters of "adjustability." Applicants traversed that argument in the reply filed May 15, 2008. In the Final Office Action dated August 20, 2008, the Examiner stated that applicant's arguments filed May 15, 2008 "were fully considered but were not persuasive." However, now the Examiner no longer relies on *In re Stevens*, but merely alleges that T-shaped and V-shaped configurations are an "obvious design choice." The Examiner did not provide any reference or even any legal precedent supporting this naked allegation. See the Final Office Action at pages 2, 6, and 9. The applicant understands that changing the rationale for an earlier rejection which was traversed is an admission by the Examiner that the traversing reply was persuasive. Otherwise, the Examiner would merely repeat the earlier rejection.

Secondly, the Examiner also stated that "since the criticality of the welded seam shape claimed by Applicant is not supported by any showing of criticality of such placement in the instant specification, nor did Applicant stated that such placement

serves any specific purpose or performs any specific function..." Final Office Action at pages 2, 6, and 9. Applicant assumes that this "criticality" argument is grounded in MPEP §2144.04, which states "If the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection." (emphasis added) By negative implication, this phrase means that if applicant does not demonstrate the criticality of a specific limitation, it might be appropriate to rely solely on case law as the rationale to support an obviousness rejection. And as noted, the Examiner did not rely on case law in the Final Office Action (or anything other than a naked allegation of obvious design choice). MPEP §2144.04 does not imply that a naked allegation of "obvious design choice" is permissible absent a showing of criticality.

Third, applicant traverses the Examiner's allegation that the criticality of the welded seam shape is not supported by the specification. The criticality of welded seam shape is that it defines the deformation of the foil bag as liquid is withdrawn from it. See specification paragraph [0074]. It is known in the art that a foil bag resists collapsing when liquid is withdrawn from it. One implication of this problem is that the amount of usable liquid is decreased, because some residual liquid is effectively trapped inside the bag instead of being delivered for its intended use. The shape of the weld seam is one factor that defines the deformation of the foil bag as liquid is withdrawn from it. Having established the criticality of the shape, the Examiner may not rely solely on legal precedent to reject the claim. In the alternative, if the Examiner disagrees with the criticality demonstration as explained in this paragraph, the Examiner would still have to at least cite relevant case law in making a rejection, as explained in the above paragraph.

Fourth, an "obvious design choice" type-rejection is precluded where the claimed structure and the function it performs are different from the prior art. See *In re Gal*, 980 F.2d 717, 25 USPQ2d 1076 (Fed.Cir. 1992). As to the claimed structure, the Examiner admits that Osgar "does not expressly disclose the bag having at least one welded seam of a substantially T-shaped or substantially V-shaped configuration." See the Final Office action at page 5. As to the function the claimed structure performs, the configuration of the weld seams defines the deformation of the foil bag as liquid is withdrawn from it. See specification paragraph [0074]. Since Osgar does not have the same structure and function as the weld seams in the instant application, the "obvious design choice" rejection is precluded. *In re Gal*.

In conclusion, the Examiner's naked allegation that T and V-shaped welds are an "obvious design choice" uses impermissible hindsight and therefore the rejections must be withdrawn.

The rejection of independent claim 20 is respectfully traversed.

The Examiner cites the definition of "propellant" from the American Heritage dictionary and alleges that "any propellant atomizer needs flow (gas or liquid) caused by the external pressure source (pressurized gas, liquid, etc.) for functioning." (emphasis added) Office Action dated 8/20/2008 at page 3.

Applicant points out that claim 20 recites, inter alia, "A propellant gas-free atomizer..." (emphasis added) The term "free" is used to modify the term "propellant gas-." In other words, claim 20 is directed at an atomizer that *does not use* propellant gas. Propellant gases are undesirable for several reasons, one of them being

environmental. With this understanding, it is apparent that the atomizer of Hughes cannot be combined with the container of Osgar to provide a "propellant gas-free atomizer" because Hughes teaches "aerosol metered dose vial 412 feeds a pressurized gas combined with and containing medicant ... pressurized gas and medicament then exits..." (emphasis added) Hughes col. 12, lines 38-41. Hughes teaches away from what is being claimed because the medicament is mixed with pressurized gas from an external source before being delivered to the patient. The patient will therefore receive gas and medicament. For at least this reason, the rejection should be withdrawn. *See* MPEP §2145 X D(2) (stating "it is improper to combine references where the references teach away from their combination.")

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Amdt. dated Dec 22, 2008
Reply to Office Action of August 20, 2008

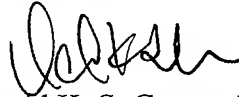
- 6 -

Freund *et al.*
Appl. No. 10/754,499

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



David K. S. Cornwell
Attorney for Applicants
Registration No. 31,944

Date: 12-22-08

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600
911227_1.DOC